

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

(Attorney Docket No. 005222.00259)

In re U.S. Application of: Guheen, et al.)	
)	
Application No. 09/321,360)	Examiner: Robinson Boyce, Akiba K
)	
Filed: May 27, 1999)	Group Art Unit: 3628
)	
For: Phase Delivery of Components of a)	Confirmation No. 6371
System Required for)	
Implementation of Technology)	

REPLY BRIEF

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Commissioner for Patents
P.O. Box 1450
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Sir:

This Reply Brief, in compliance with 37 U.S.C. § 41.41, is presented in response to the Examiner's Answer mailed on September 27, 2007.

The arguments in this Reply Brief complements the arguments included in Appellant's Brief. On pages 11-14 of the Examiner's Answer, the Examiner responded to the arguments raised by the Appellant. Appellant is responding to the new arguments presented by the Examiner. Appellant has also presented additional non-obviousness considerations.

Rassman Teaches Away From the Claimed Invention

The final Office Action fails to establish a *prima facie* case of obviousness because the applied art of Rassman teaches away¹ from "identifying, from the plurality of components, a first component group containing additional components, the additional components being required

¹ "The Court relied upon the corollary principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious." (*KSR Int'l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007) discussing *United States v. Adams*, 383 U.S. 39, 51-52 (1996)).

for an implementation of the system, the optional components being optional for the implementation of the system” and “logic for identifying, from the plurality of components, a first component group containing additional components, and a second component group containing optional components, the additional components being required for an implementation of the system, the optional components being optional for the implementation of the system” as claimed in independent claims 1 and 13, respectively. *See MPEP 2144.05 (B)(III)* (a *prima facie* case of obviousness may be rebutted by showing that the art, in any material way, teaches away from the claimed invention (internal citations omitted)).

The claimed invention recites, among other features, “optional components being optional for the implementation of the system.” The Examiner equates the claimed “optional components” to the “secondary resources” described in Rassman. The recited “optional components” are not equal to the “secondary resources” and Rassman teaches against equating them. The teachings relied on by the Examiner as disclosing the claimed features are directed to scheduling resources for surgical procedures in a hospital environment (see e.g., Fig. 1; column 4, line 16 to column 14, line 8). Rassman teaches that operating rooms are considered primary resources and surgeons, for example, are secondary resources. *See, e.g.*, column 6, lines 19-38. Thus, equating a surgeon to an optional component optional for a surgical procedure materially teaches away from the claimed invention since a surgeon is not optional in a surgical procedure. For this same reason, reading Rassman as teaching or disclosing the claimed “optional components” would render it unsatisfactory for its intended purpose of scheduling surgical procedures since logically a surgical procedure cannot be scheduled without a surgeon. *See MPEP 2143.01 (V)* (the proposed modification cannot render the prior art unsatisfactory for its intended purpose).

In addition, the applied references of Rassman and Turnbull only disclose necessary components which are required and fail to disclose or suggest “optional components being optional for the implementation of the system,” as claimed. For example, Rassman discloses secondary resources which are not optional resources, as claimed. Turnbull, describes requirements remaining to be preformed but also does not disclose or suggest that these remaining requirements are optional requirements. To the contrary these, remaining requirements are necessary and required prior to introduction of the product to market. Thus, the Final Office Action relies on impermissible hindsight to disclose these features in the prior art

since nowhere do the applied references disclose or suggest “optional components being optional for the implementation of the system.”

The Final Office Action makes a further leap claiming that Turnbull discloses “an ordered listing of the additional components for implementation into the existing system, the ordered listing providing an order that is required for installing the components in the web architecture framework,” as claimed. As explained during prosecution, in the Reply and herein, the applied art including Turnbull is silent as to the “ordered listing,” as claimed, and it would not be obvious to one of ordinary skill in the art that to modify Turnbull to include this feature without the benefit of impermissible hindsight. (MPEP §2145 (X)(A).)

Therefore, for at least these reasons, the Final Office Action fails to establish a *prima facie* case of obviousness.

Rassman Cannot be Relied on Because it is Directed to Non-analogous Art

The claimed inventions are directed to displaying phases in which components must be delivered for providing a web architecture. However, as described earlier, the Final Office Action depends on teachings of Rassman that are directed to scheduling resources for surgical procedures in a hospital environment (see e.g., Fig. 1; column 4, line 16-column 14, line 8). Therefore, the teachings relied on by the Examiner are in a different field of endeavor with respect to the claimed inventions. Moreover, the teachings of Rassman are directed to resolving resource conflicts with a plurality of surgical procedures and do not distinguish between installing primary resources before secondary resources. Thus, the teachings of Rassman are not reasonably pertinent to the particular problem which the invention was concerned. “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of an applicant’s endeavor or, if not, then must be reasonably pertinent to the particular problem with which the inventor was concerned.” (MPEP §2141.01(a)(I); *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)).

Therefore, Rassman cannot be relied on because it is directed to non-analogous art, thus the rejection of the claims based on Rassman should be withdrawn for these additional reasons.

Moreover, Turnbull is directed to the manufacture of semiconductor product development (Figs. 6-15c) and fails to provide any consideration for delivering a web

architecture. Thus, the combination of Rassman and Turnbull is improper and Appellant requests the rejections based on the combination be withdrawn.

Even if Rassman and Turnbull Could be Modified or Combined, the Combination Does Not Disclose or Suggest the All of the Claimed Features

Appeal Brief Argument 1

Appellant reiterates that the combination of Rassman and Turnbull fails to teach the feature of "identifying, from the plurality of components, a first component group containing additional components and a second component group containing optional components, the additional components being required for an implementation of the system, the optional components being optional for the implementation of the system." In the Examiner's Answer, the Examiner argues (Pages 11-12):

In addition, in col. 8, lines 20-36, the implementation of an application where the display of secondary resources can be employed to make additional options available. These additional options represent the optional components. Appellant argues that these are merely optional display functions for displaying a representation of a secondary resource. However, Rassman specifically discloses that "secondary resources could also be employed to make additional options available" in lines 29-30, thus indicating that by displaying these secondary resources, that options are derived from the secondary resources, and that secondary resources can be used for additional options, thereby representing a second component group containing optional components.

Rassman discloses (Column 7, lines 22-30. Emphasis added.):

After collecting and usually, but not necessarily, after loading the relevant information into the data bank, the operator decides which resources are to be "primary" **for display purposes** and which are to be "secondary". In the hospital setting the operator may select "operating rooms" for display as the primary resources. **Alternatively, "surgeons" or "heart/lung machines" or "CT scanners" or "nuclear magnetic imagers" etc. or some combination thereof might be chosen.**

Rassman merely discloses that the operator selects secondary resources and primary resources based on display purposes. Rassman further discloses (Column 8, lines 29-36.):

The display of secondary resources could also be employed to make additional options available. For example, instead of having to go through a menu, simply by moving the cursor to one of those displayed secondary resources, the system could be made to display a window with that secondary resources schedule or other information about that secondary resource. Such a window is shown in FIG. 9.

Rassman is merely disclosing a display option, in which information about a secondary resource is displayed in a window rather than the operator having to go through a menu to obtain this information. Moreover, contrary to what is suggested by the Examiner, the secondary resource cannot be equated to the claimed “optional components being optional for the implementation of the system,” as described above.

Turnbull fails to remedy the above deficiencies of Rassman. Appellant respectfully submits that the combination of Rassman and Turnbull fails to even suggest the feature of “identifying, from the plurality of components, a first component group containing additional components and a second component group containing optional components, the additional components being required for an implementation of the system, the optional components being optional for the implementation of the system,” as in claim 1, the feature of “a code segment that identifies, from the plurality of components, a first component group containing additional components and a second component group containing optional components, the additional components being required for an implementation of the system, the optional components being optional for the implementation of the system” as in claim 7, and the feature of “logic for identifying, from the plurality of components, a first component group containing additional components and a second component group containing optional components, the additional components being required for an implementation of the system, the optional components being optional for the implementation of the system” as in claim 13.

Appeal Brief Argument 2

Appellant argues that the combination of Rassman and Turnbull fails to teach the feature of “compiling, by the processor, an ordered listing of the additional components for implementation into the existing system, the ordered listing providing an order that is required for installing the components in the web architecture framework.” In the Examiner’s Answer, the Examiner argues (Pages 12-13.):

It is Turnbull that discloses the ordered listing. Specifically, in Col. 4, lines 14-20, Turnbull shows that any person desiring to know the status of product development/production can access the product control matrix 100, which informs the person of requirements that have been completed, which constitutes as the required requirements that have been completed for the development of products [which includes installation of components].

Turnbull discloses (Column 4, lines 14-20):

Any person desiring to know the status of the product development and/or the product production simply accesses product control matrix 100. Examination of product control matrix 100 immediately informs the person of the requirements that have been completed and the requirements remaining to be performed prior to introduction of the product to market.

Turnbull merely discloses the requirements that have been completed and the remaining requirements that need to be completed. However, the above teaching does not even suggest that the completed requirements must be completed before the remaining requirements. Moreover, Turnbull does not suggest an ordering of either the completed requirements or the remaining requirements.

Rassman fails to remedy the above deficiencies of Turnbull. Appellant respectfully submits that the combination of Rassman and Turnbull fails to even suggest the feature of “compiling, by the processor, an ordered listing of the additional components for implementation into the existing system, the ordered listing providing an order that is required for installing the components in the web architecture framework,” in claim 1, the feature of “a code segment that compiles an ordered listing of the additional components for implementation into the existing system, the ordered listing providing an order that is required for installing the components in the web architecture framework” in claim 7, and the feature of “logic for compiling an ordered listing of the additional components for implementation into the existing system, the ordered listing providing an order that is required for installing the components in the web architecture framework” in claim 13.

Appeal Brief Argument 3

Regarding claim 19, Appellant argues that the combination of Rassman and Turnbull fails to teach the feature of “separating the remaining components into primary components and secondary components, wherein the primary components must be installed before the secondary

components can function properly.” In the Examiner’s Answer, the Examiner argues (Pages 13-14):

However, the establishment of predetermined sequences, where it is necessary that one step be completed before the other as shown in cot. 11, lines 19- 24 of Rassman, thereby indicating that primary components used in a first step need to be installed first in order to complete that step, and move on the next step, which involve secondary components. In addition, the primary components of Rassman must be installed before the secondary components can function properly as shown in the operating room example in Col. 6, lines 19-38. In this case, the actual operating room must be incorporated into the process first before any of the secondary resources including the surgeon S, anesthesiologist A, heart/lung machine H and heart monitor M can be implemented to successfully complete the process.

Referring to argument 1, Rassman merely discloses that the operator selects secondary resources and primary resources based on display purposes. (Column 7, lines 22-30.) Thus, referring to the above allegation, an operating room may be selected as either a primary resource or a secondary resource.

Turnbull fails to remedy the above deficiencies of Rassman. Appellant respectfully submits that the combination of Rassman and Turnbull fails to even suggest the feature of “separating the remaining components into primary components and secondary components, wherein the primary components must be installed before the secondary components can function properly,” as claimed.

CONCLUSION

Appellant respectfully requests reversal of the above rejections. If the Board is of the opinion that any rejected claim may be allowable in amended form, Appellant would respectfully request a statement to that effect.

Respectfully submitted,

Date: November 21, 2007

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